



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 05/17/2002

Gerard F. Dunne
156 Fifth Avenue Suite 1223
New York, NY 10010

EXAMINER

STERLING, AMY JO

ART UNIT	PAPER NUMBER
----------	--------------

3632

DATE MAILED: 05/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,423

Applicant(s)

NOVAK ET AL.

Examiner

Amy J. Sterling

Art Unit

3632

-- Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3632

This is the second non-final Office Action for application number 09/909423, Decorative Gift Bag Balloon Holder, filed on 7/19/01. Claims 1-16 are pending.

Information Disclosure Statement

The listing of references in the specification is still not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, 9, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled the Fun Place, dated March 25, 1999 found on the

Art Unit: 3632

internet at: <http://www.thefunplace.com/crafts/bagswrap.html> and in view of United States Patent No. 5441348 to Valentino.

The Fun Place publication discloses a balloon holder having a decorative bag, a core is tucked on the inside of the bag, having sufficient weight to hold at least one buoyant balloon in place and positioned within the decorative bag, and decorative material covering the core in a position to conceal the core from casual view.

The Fun Place reference does inherently disclose in its teachings that the core, the decorative bag and the decorative material are secured together and therefore these limitations do not have to be specifically recited, in order to be a valid rejection. Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In fact, the core is said to be "tucked", which means to "conceal snugly", or to "hold tightly" (Webster's Dictionary 10th Edition), both which inherently mean that the core is secured to the bag. The decorative material "covers" the core, also does not rule out the fact that securing the two elements together is inherently taught in the reference. (For using extrinsic evidence to explain terms see In re Baxter Travenol Labs., 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991).

Even if not inherently taught in the reference, it is well known to the public domain, in any art, to use a liner, such as the tape, cited by the applicant in the specification, (page 10, items 34, 36), to secure items to their desired locations. This securing of decorative elements, in order to hold them to their desired locations, if not inherent, is an obvious permutation of the balloon holder, recited by the Fun Place

Art Unit: 3632

reference and is therefore, unpatentable. (For taking official notice of well-known prior art see In re Ahlert, 424 F.2d 1088, 1091 165 USPQ 418, 420 (CCPA 1970).

The Fun Place publication does not specifically disclose where the decorative material could be formed from a length of decorative sheet material having its upper portion cut in to a series of strips adapted to extend outwardly from the decorative bag and its lower portion covering the peripheries of the core.

This particular limitation is shown in Valentino (See the last sentence in the abstract), stating that the "upper portion of each length of paper is cut longitudinally to enable the length to be...individually separated so that they may be able to form a decorative surface for an item placed within the bag". Valentino uses the structure in order to keep all of the decorative strands of one piece, so that strands do not fall out of the bag, during use. Therefore, it would be obvious from the teachings of Valentino to use this type of decorative material in the Fun Place reference, to keep the strands from falling out of the bag, during use.

Claims 4, 6, 10, 12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled the Fun Place, dated March 25, 1999 found on the internet at: <http://www.thefunplace.com/crafts/bagswrap.html> and in view of United States Patent No. 5441348 to Valentino and further in view of United States Patent No. 5044773 to Harms.

The only positive limitation cited in claims 4, 6, 10, 12, 15 is that the decorative bag has handles extending from an upper portion thereof. The functional language "to serve as an attachment for a string of one or more balloons" is only a suggested use

Art Unit: 3632

and though the intended function of the device must not be used in conjunction with a reference, that in use would destroy the essence of the reference, the actual or same function does not need to be specifically taught or disclosed, in order for the rejection to be valid. See MPEP 2114.

Therefore, the original rejection cited in the first Office Action regarding claims 4, 6, 10, 12, 15 stands as originally rejected, since securing a balloon to the handles in Harms, would not destroy the essence of the invention described in Harms.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled The Party Balloon, dated 2/2/01 found on the internet at: <http://www.thepartyballoon.com/products.html> in view of United States Patent No. 5441348 to Valentino.

The claims 1-4, 6, 8-10, 12, 14, 15 are rejected under 103(a) for the same reasons as cited above.

Claims 5, 7, 11, 13, 16 are rejected because The Party Balloon publication shows that the handles of the bag are secured together.

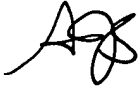
Conclusion

Inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for

Art Unit: 3632

the Technology center is 703-305-3597 or 703-305-3598 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS
Amy J. Sterling
5/8/02



LESLIE A. BRAUN
SUPERVISORY PATENT EXAMINER